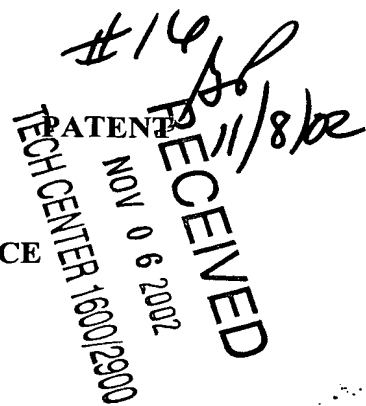
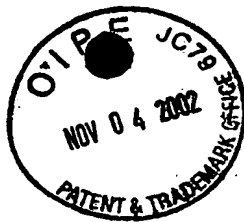


NOVA-0076



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

**Michael S. Dobres, Aidyn Mouradov and Hong Zhang**

Serial No.: 09/911,588

Group Art Unit: 1638

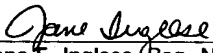
Filed: **July 24, 2001**

Examiner: **Georgia L. Helmer**

For: **TRANSFORMATION OF PLANTS BY ELECTROPORATION  
OF CULTURED EXPLANTS**

I, **Jane E. Inglesse**, Registration No. 48,444 certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

On *October 25, 2002*

  
Jane E. Inglesse, Reg. No. 48,444

Assistant Commissioner for Patents  
Washington, D.C. 20231

**REPLY UNDER 37 C.F.R. § 1.143  
TO OFFICE ACTION DATED OCTOBER 2, 2002**

Reconsideration of the requirement for restriction is respectfully requested in view of the following remarks.

**Restriction Requirement**

A restriction has been required under 35 U.S.C. § 121 to one of three groups of inventions said to be defined by the claims, characterized as Groups I to III. The claims and subject matter associated with each group are set forth below.

Group I, encompassing claims 1 to 20 and 28 to 43,  
drawn to methods of transforming plants with a transgene,  
classified in class 800, subclass 278;

Group II, encompassing claims 21 to 23, drawn to  
transgenic plants produced by the methods of claims 1 to 20,  
classified in class 800, subclass 323.1, 323.2, and 323.3;

Group III encompassing claims 24 to 27, drawn to  
methods of producing transgenic plants lacking a marker gene,  
classified in class 800, subclass 278.

The Office Action asserts that the inventions of Groups I to III are patentably distinct.  
Applicants respectfully traverse the restriction requirement.

Applicants respectfully submit that the relationship among the subject matter defined  
by the present claims is such that a reasonable search of the transformation methods defined  
by the claims of Groups I would necessarily lead to disclosures, to the extent any exist, of the  
transgenic plants produced by such methods, which are defined by the claims of Group II.  
Accordingly, a search and examination of the subject matter encompassed by Groups I and II  
would not impose a serious burden on the Examiner.

Moreover, Applicants respectfully submit that a search and examination of the subject  
matter encompassed by Group III, in addition to that of Groups I and II, would not impose a  
serious burden on the Examiner. The relationship among the subject matter defined by the  
present claims is such that a reasonable search of the transformation methods defined by the  
claims of Group I would necessarily lead to disclosures, to the extent any exist, of the  
transformation methods defined by the claims of Group III. The subject matter defined by  
the claims of Groups I and III has been classified in the same class and subclass,

demonstrating a recognition in the art of a single subject of inventive effort, and indicating that a single field would be required to search the entirety of the claimed subject matter. Accordingly, Applicants respectfully submit that a search and examination of the subject matter encompassed by Groups I, II, and III would not impose a serious burden on the Examiner.

In accordance with 37 CFR § 1.143, applicants hereby provisionally elect the subject matter of Group I for prosecution on the merits, encompassing claims 1 to 20 and 28 to 43.

#### **Conclusion**

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable Action is respectfully requested.

Respectfully submitted,

Date: *October 25, 2002*

*Jane E. Inglese*  
**Jane E. Inglese, Ph.D.**  
Registration No. **48,444**

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One Liberty Place - 46th Floor  
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1638

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PATENT

DOCKET NO.: NOVA-0076



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In Re Application of:**

Dobres, et al.

**Confirmation No.:** 4361

**Serial No.:** 09/911,588

**Group Art Unit:** 1638

**Filing Date:** July 24, 2001

**Examiner:** G.L. Helmer

**For:** Transformation of Plants by Electroporation of Cultured Explants

DATE OF DEPOSIT: October 25, 2002

I HEREBY CERTIFY THAT THIS PAPER IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO THE ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, DC 20231.

Jane E. Inglese  
TYPED NAME: Jane E. Inglese  
REGISTRATION NO.: 48,444

Box ☒ NON-FEE

☐ AF

Assistant Commissioner for Patents  
Washington DC 20231

Sir:

**REPLY TRANSMITTAL LETTER**

Transmitted herewith for filing in the above-identified patent application is:

- ☐ A Preliminary Amendment.
- ☒ An Amendment Responsive to the Office Action Dated October 2, 2002.
- ☐ An Amendment Supplemental to the Paper filed \_\_\_\_\_.
- ☐ Other: \_\_\_\_\_.

- ☒ Applicant(s) has previously claimed small entity status under 37 CFR §1.27.
- ☐ Applicant(s) by its/their undersigned attorney, claims small entity status under 37 CFR §1.27 as:
- ☐ an Independent Inventor
  - ☐ a Small Business Concern
  - ☐ a Nonprofit Organization
- ☐ This application is no longer entitled to small entity status. It is requested that this be noted in the files of the U.S. Patent and Trademark Office.
- ☐ Loss of Entitlement Enclosed
- ☐ Substitute Pages \_\_\_\_\_ of the Specification are enclosed.
- ☐ An Abstract is enclosed.
- ☐ \_\_\_\_\_ Sheets of Proposed Corrected Drawings are enclosed.
- ☐ A Certified Copy of each of the following applications: \_\_\_\_\_  
\_\_\_\_\_ is enclosed.
- ☐ An Associate Power of Attorney is enclosed.
- ☐ Information Disclosure Statement.
- ☐ Attached Form 1449.
  - ☐ A copy of each reference as listed on the attached Form PTO-1449 is enclosed herewith.
- ☐ Appended Material as follows: \_\_\_\_\_
- ☐ Other Material as follows: \_\_\_\_\_

## FEE CALCULATION

☒ No Additional Fee is Due.

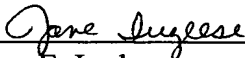
				SMALL ENTITY		NOT SMALL ENTITY	
	REMAINING AFTER AMENDMENT	HIGHEST PAID FOR	EXTRA	RATE	FEE	RATE	FEE
TOTAL CLAIMS	128	128 (20 MINIMUM)	0	\$9 EACH	\$0	\$18 EACH	\$
INDEP. CLAIMS	3	3 (3 MINIMUM)	0	\$42 EACH	\$0	\$84 EACH	\$
FIRST PRESENTATION OF MULTIPLE DEPENDENT				\$140	\$0	\$280	\$
<input type="checkbox"/> ONE MONTH EXTENSION OF TIME				\$55	\$0	\$110	\$
<input type="checkbox"/> TWO MONTH EXTENSION OF TIME				\$200	\$0	\$400	\$
<input type="checkbox"/> THREE MONTH EXTENSION OF TIME				\$460	\$0	\$920	\$
<input type="checkbox"/> FOUR MONTH EXTENSION OF TIME				\$720	\$0	\$1440	\$
<input type="checkbox"/> FIVE MONTH EXTENSION OF TIME				\$980	\$0	\$1960	\$
<input type="checkbox"/> LESS ANY EXTENSION FEE ALREADY PAID				minus	(\$0 )	minus	(\$ )
<input type="checkbox"/> TERMINAL DISCLAIMER				\$55	\$0	\$110	\$
<input type="checkbox"/> OTHER FEE OR SURCHARGE AS FOLLOWS:					\$0		
TOTAL FEE DUE					\$0		\$

- ☐ A check is enclosed in the foregoing amount due.
- ☐ Petition is hereby made under 37 C.F.R. 1.136(a) (fees: 37 C.F.R. § 1.17(a)(1)-(4) to extend the time for response to the Office Action of @@ to and through @@ comprising an extension of the shortened statutory period of @@ month(s).
- ☒ The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account 23-3050. This sheet is provided in duplicate.

- ☒ The Commissioner is authorized to charge payment of the following fees and to refund any overpayment associated with this communication or during the pendency of this application to Deposit Account 23-3050. This sheet is provided in duplicate.
- ☐ The foregoing amount due for filing this paper.
- ☒ Any additional filing fees required, including fees for the presentation of extra claims under 37 C.F.R. 1.16.
- ☒ Any additional patent application processing fees under 37 C.F.R. 1.17 or 1.20(d).

**SHOULD ANY DEFICIENCIES APPEAR** with respect to this application, including deficiencies in payment of fees, missing parts of the application or otherwise, the U.S. Patent and Trademark Office is respectfully requested to promptly notify the undersigned.

Date: October 25, 2002

  
\_\_\_\_\_  
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